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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,789	03/29/2004	William John Nasuti	343355600076	9489
John V. Biernacki <sup>7590</sup> Jones Day North Point 901 Lakeside Avenue Cleveland, OH 44114			EXAMINER WANG, RONGFA PHILIP	
			ART UNIT 2191	PAPER NUMBER
			MAIL DATE 12/23/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/811,789

**Applicant(s)**

NASUTI ET AL.

**Examiner**

PHILIP WANG

**Art Unit**

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 7-9, 16, 17 and 25-29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 7-9, 16, 17 and 25-29 is/are rejected.  
7) ☒ Claim(s) 29 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 04 September 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to amendment filed on 9/4/2009.
2. Per Applicant's request, claims 1, 7-9, 16, 17, and 25 have been amended. Claims 2-6, 11-15, 18, and 22-24 are canceled. Claims 26-29 are new claims added. Drawing Fig. 1 is amended.
3. Claims 1, 7-9, 16-17, and 25-29 remain pending.

### ***Claim Objections***

4. Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 is a system claim and claim 29 depends on claim 1. Claim 29 recites the limitation of a user's knowledge of each separate environment. A user's knowledge has no bearing on what the claimed system of claim 1. It is therefore claim 29 does not further limit the subject matter of claim 1.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 28 recites the limitation of "an application automation map". It appears the specification has no disclosure of such limitation. Since the definition of the limitation is not clear, the examiner interprets the claim comprises limitation of translating some code.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 7-9, 16-17, and 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 26, and 27, recites the limitation "the code" in "using the list to generate and execute the code". There is insufficient antecedent basis for this limitation in the claim.

Dependent claims of the above claims suffer the same deficiency.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 7, 17, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavela (USPGN 2002/0029377) in view of Kamani et al. (USPGN 2005/0015666).

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As per claim 1 and similarly claims 26 and 27,

Pavela discloses

**one or more processors;**

**a computer-readable storage medium containing instructions configured to cause the one or more processors to perform operations including (c4:45, "...computer processing):**

**creating a file containing a list of required actions for testing an application ([0011], "...defining a source file...for performing a portion of the automatic test procedure..." ), wherein the file is created on a test design automation independent tool within a first insulated environment (the environment that is used for creating the source file is considered a first insulated environment), wherein the file is automatically transmitted to a test coding and execution automation independent tool in a second insulated environment([0011], "...generating and automated test code for the automated test procedure from the source file." )**

Pavela does not specifically disclose

--The second insulated environment is separate from the first insulated environment.

However, Pavela suggests relieving a system test designer from writing a automated code ([0009], "...relieves the system test designer from writing the automated code..."). Therefore, one with ordinary skill in the art at the time the invention was made would be motivated to modify the system of Pavela to separate a test design environment (the first insulated environment) from the code automated generation environment (the second insulated environment) to enable a test designer to perform his/her task without knowing code generation

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environment as suggested by Pavela (further see [0009], "...relieves the test designer from the burden of familiarize themselves with...each and every system element used by the software...").

Pavela further discloses -

**receiving the file in the second insulated environment and using the list to generate and execute the code to test the application** (Fig. 2, 206, for generating automated test code) **and produce test results** ([0064], "...test results are provided..."), **wherein the code is generated and executed using the test coding and execution automation independent tool in the second insulated environment** (as explained previously),

Pavela does not specifically disclose

and wherein the test results are automatically transmitted to a test analysis automation independent tool in a third insulated environment;  
and receiving the test results in the third insulated environment and comparing the received test results to one or more other received test results, wherein the comparison is done using the test analysis automation independent tool in the third insulated environment.

However, Kamani discloses

**and wherein the test results are automatically transmitted to a test analysis automation independent tool in a third insulated environment;**  
**and receiving the test results in the third insulated environment and comparing**

**the received test results to one or more other received test results, wherein the comparison is done using the test analysis automation independent tool in the third insulated environment** ([0012], "...isolating the evaluation of actual test result against expected test result from the test module...The test module sends the actual test results to a results evaluation sub-system. The result evaluation sub-system receives the actual test result"; [0008], "...compare actual resulting output...")

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kamani et al. into the teachings and suggestions of Pavela to include the limitation disclosed by Kamani et al. . The modification would be obvious to one of ordinary skill in the art want to allow test evaluator to evaluate test results independent of test module as suggested by Kamani et al. ([0011], [0006]).

As per claim 7,  
the rejection of claim 1 is incorporated;  
Kamani et al. discloses:

**wherein the automatically transmitting of the test results to the test analysis automation independent tool in the third insulated environment involves copying or moving the test results from the second insulated environment to the third insulated environment** ([0012], "The test module send the actual test results to a results evaluation sub-system...").

As per claim 17, the rejection of claim 1 is incorporated;

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Kamani et al. discloses:

wherein the testing criteria includes an action to test performance of the computer program([0005], "...test the performance of one or more functions...").

As per claim 25, the rejection of claim 1 is incorporated;

Pavela/ Kamani discloses

**wherein the first insulated environment, the second insulated environment, and the third insulated environment operate on a network such that each of the environments are accessible through different computer terminals;**

**wherein the first insulated environment operates on a first computer which does not contain the second insulated environment or the third insulated environment;**

**wherein the second insulated environment operates on a second computer which does not contain the first insulated environment or the third insulated environment;**

**wherein the third insulated environment operates on a third computer which does not contain the first insulated environment or the second insulated environment(continue from the rejection of claim 1, the combination of Pavela and Kamani appears to disclose such limitation).**

As per claim 28,



Pavela discloses

**The generated code is translated into an application automation map using an application framework, and wherein the application automation map is used to test the application** (see claim 14, "...generating test code for the automated test procedure...translating the executable code objects...").

As per claim 29,

Pavela/ Kamani discloses

**A user can operate independently within each separate environment without having knowledge of the other two environments** (continue from rejection of claim 1, the 1st, 2nd and 3rd environments are separated, and therefore a user can operate independently.).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pavela (USPGN 2002/0029377) in view of Kamani et al. (USPGN 2005/0015666) and further in view of Hansen (US Pat. # 6,449,744 B1 ).

As for claim 8, both Pavela /Kamani et al. do not explicitly disclose:

the third insulated environment includes an internet web browser for viewing test results.

However, Hansen discloses:

**the third insulated environment** (the test environment 250, Col. 5, lines 19- 20)  
**includes an internet web browser** (a web browser 252, Col. 5, line 25) **for viewing test results** (Col. 7, lines 62,65 and Fig. 3A).

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It would have been obvious to one of ordinary skill in the art at the time of invention was made to combine the teachings of Pavela /Kamani et al. with the teachings of Hansen by having the test results analysis environment that includes an internet web browser in order for the local tester and the remote tester to exchange data representing the test program and test results through a network (Hansen, Col. 4, lines 15-18).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pavela (USPGN 2002/0029377) in view of Kamani et al. (USPGN 2005/0015666) and further in view of Tazoe et al. (USPTN 6,326,985).

As for claim 9, both Pavela /Kamani et al. do not explicitly disclose:

format of the received test results include JPEG, HTML, GIF and combinations thereof.

However, Tazoe et al. discloses:

format of the received test results include JPEG, HTML, GIF, and combinations thereof (c16, 53-56, "HTML files..GIF files...JPEG files...on the display").

It would have been obvious to one of ordinary skill in the art at the time of invention was made to combine the teachings of Pavela /Kamani et al. with the teachings of Tazoe et al. by having format of the received test results (data) to include JPEG, HTML, GIF, and combinations thereof in order to share test results and viewable by web browser.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pavela (USPGN 2002/0029377) in view of Kamani et al. (USPGN 2005/0015666) and further in view of DeLong (USPTN 5,892,947).

As per claim 16,  
the rejection of claim 1 is incorporated;  
Pavela/ Kamani does not specifically disclose  
wherein the testing criteria includes an action to test a computer-human interface generated by the computer program.  
However, DeLong discloses

**wherein the testing criteria includes an action to test a computer-human interface generated by the computer program(GUI test, Col. 4, line 11).**

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of DeLong into the teachings of Pavela/ Kamani to include the limitation disclosed by DeLong. The modification would be obvious to one of ordinary skill in the art to want to test GUI as GUI applications are most commonly used applications.

***Response to Arguments***

11. Applicant's arguments with respect to argued claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Wang whose telephone number is 571-272-5934. The examiner can normally be reached on Mon - Fri 8:00 - 4:00PM. Any inquiry of general nature or relating to the status of this application should be directed to the TC2100 Group receptionist: 571-272-2100.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached on 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip R. Wang/ 12/20/2009

Patent Examiner